

REMARKS

Applicants have studied the Office Action dated October 5, 2005, and have made no amendments to the claims. Reconsideration and allowance of the pending claims in view the following remarks are respectfully requested. Applicants submit that the application, as amended, is in condition for allowance or alternatively is in better form for consideration on appeal. In the Office Action, the Examiner:

- Rejected claims 1-8, 10-17, and 19-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0188854 A1 to Heaven et al.; and
- Rejected claims 9, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0188854 A1 Heaven et al. in view of U.S. Patent Publication No. 2002/0174125 to Lucovsky et al.

Telephonic Interview

As an initial matter, the Applicants would like to thank Examiner Venkatanaray Perungavoor for the telephone interview on Monday December 5, 2005. Participating in the telephone call were Jon Gibbons and Thomas Grzesik, attorneys for the Applicants. There were no exhibits used in the telephone interview. The Applicants' representatives discussed the teaching of Heaven with respect to claim 1 of the present invention. More specifically, the deficiencies of Heaven with respect to claim element of a digital property rights list that identifies at least a first associated digital property rights module and at least a second associated digital property rights module was discussed. The Examiner agreed, under advisement, that the use of a first digital rights module and a second digital rights module, which is an associated extension rights control module for generating an authorization for a desired type of access to a data set, is different than Heaven's teaching of a single local rights module. Also, the Examiner agreed that the Heaven reference failed to teach a digital rights property list identifying both the first and second property rights module.

Overview of the Present Invention

The present invention provides a system and method for dynamically extending a Digital Rights Management (DRM) system using authenticated external Digital Property Rights (DPR) modules. In recent years, technology advances have allowed the practical copying of digital multi-media data sets onto writable media or the communications of these data sets among numerous people. As a result an increase in the copying, pirating, and unauthorized sharing of digitized multi-media presentations has occurred. Various techniques have been used to try to prevent unauthorized copying of multi-media presentations. The data set that comprises the multi-media presentation referred to as the media data set, is encrypted using the various techniques known in the art. Encryption of the media data set has limited effectiveness since the equipment that "plays back" or presents the multi-media presentation to a user must decrypt the media data set to allow playback, thereby requiring dissemination of the encryption technique to all product manufacturers.

The commercial grade encryption techniques are also subject to development of decryption algorithms. The encryption technique used for video DVDs, for example, has been compromised by public release of a decryption algorithm used in DVD players. The publicly owned base of existing DVD players precludes changing the encryption algorithms used for that media once an encryption technique is compromised. Encryption protection by itself in existing player systems is also limited to authorizing access to the media data set and is not able to provide flexible limitations on the types of usage rights that may be granted to the media data set. Different types of usage rights that an owner of a media data set is interested in controlling include the right to modifying the data, immediate access to the entire media data set instead of progressive access over the course of the multi-media presentation, or access to permit deletion of parts of the media data set. Encryption of other types of data, such as a database or financial document, similarly fails to provide the ability to control the type of accesses or usages that may be authorized for the data.

Alternative protection techniques have been developed which support controlling different types of usage rights for a media data set. These systems, referred to as

DRM Systems, are able to restrict access to data sets by limiting authorization to one or more types of usages of a data set in response to specified usage conditions. Access control in these systems is controlled through specified DPRs. An example of a DPR is a right to only read a particular media data set for a specified number of times. Such a DPR may be used to provide a free or low cost demonstration of the multi-media data set. Existing systems support a variety of conditions on usage of the media data set and those conditions may be specified on a remote license server, but the available types of usages that may be authorized are fixed by the implementation and may not be flexibly varied by the owners of the copyright on a media data set.

To overcome the problems in the prior art, the present invention, as recited for the claims, retrieves a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module. The at least first associated digital property rights module resides in a Digital Rights Management core and the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core. The present invention identifies the associated extension rights control module specified in the digital property rights list for generating an authorization for a desired type of access to a data set. The present invention also requests the authorization for the desired type of access to the data set through the associated extension rights control module. The authorization is received from the associated extension rights control module if a set of usage conditions for the desired type of access is satisfied. The desired type of access is granted in response to receipt of the authorization.

Rejection under 35 U.S.C. §102(e) as being anticipated by Heaven.

As noted above, the Examiner rejected claims 1-8, 10-17, and 19-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0188854 A1 to Heaven et al. Referring to claims 1 and 19, the Examiner at page 3 of the Office Action states that Heaven discloses *"the retrieving digital property rights lists identifying first*

SOM92001001US1

Page 10 of 19

10/051,344

associated digital property rights module and a second digital property rights module where the first is located within digital rights management core and second is separate from core see Fig.1 item 28, 32". The Applicants respectfully disagree.

The present invention recites "retrieving a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in a Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core". FIG. 1 of Heaven shows a local rights module 28 residing within a user computer system and a rights profile module 32 residing within a BRM server 14. The Examiner states that FIG. 1 of Heaven, particularly items 28, and 32 disclose the above claim element.

However, nowhere does Heaven teach or suggest retrieving a "digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module...the at least second associated digital property rights module is an associated extension rights control module..." In fact, Heaven is completely silent on this claim element. The Office Action is unclear as to how the Examiner is supporting the assertion that Heaven teaches a digital property rights list identifying at least a first and at least a second digital property rights module. The Examiner only identifies items 28 and 32 in FIG. 1 of Heaven. Assuming arguendo that the Examiner is asserting that the rights profile module 32 is the digital property rights list, then the rights profile module 32 cannot be the second digital property rights module. In other words, the rights profile module 32 cannot be both the digital property rights list and the second digital property rights module. Accordingly, the present invention distinguishes over Heaven for at least these reasons.

Continuing further, assuming arguendo that the user profile as taught by Heaven is a digital property rights list because it contains the usage rights a user has with specific media files, nowhere does Heaven teach that the user profile identifies "at least a first

associated digital property rights module and at least a second associated digital property rights module". The only information included in the user profile is a list of media files assigned to the user, the usage rights a user has for the media, and the scope, terms, and limitations of that use. See Heaven at paragraph 0020. Accordingly, the present invention distinguishes over Heaven for at least these reasons as well.

Furthermore, the Applicants respectfully suggest that any comparison between the second digital property rights module as recited for claims 1 and 19 to the rights profile module 32 is unfounded. A digital property rights module, as recited for the present invention, is associated with a usage right specified by the digital property rights list and "verif[ies] satisfaction of a specified set of usage conditions required for each usage right. See the Specification as originally filed, for example, at page 8, lines 10-14. The rights profile module 32 of Heaven is "geared to accept information on users, media files and the rights conditions that associated them". Stated differently, the usage rights profile module 32 in Heaven is a digital property rights list of the various users. Nowhere does Heaven teach or suggest that the rights profile module 32 is a digital property rights module as recited for the present invention. In other words, nowhere does Heaven teach or suggest that the rights profile module 32, is associated with a usage right specified by the digital property rights list and "verif[ies] satisfaction of a specified set of usage conditions required for each usage right. Accordingly, the present invention distinguishes over Heaven for at least these reasons as well.

The Examiner at page 3 of the Office Action also states that Heaven discloses "*the controlling access to a data set by identifying an associated extension rights control module and generating of authorization for desired type of access to a data set by identifying an associated extension rights control module and generating of authorization for desired type of access to a data set see Par. 0022 & Par. 0020 & Par. 0003*". The Applicants respectfully disagree. This is not the same as a second digital property rights module as specified in the digital property rights list for "generating an authorization for a desired type of access to a data set".

The present invention recites "identifying the associated extension rights control module specified in the digital property rights list for generating an authorization for a desired type of access to a data set; requesting the authorization for the desired type of access to the data set through the associated extension rights control module; receiving the authorization from the associated extension rights control module if a set of usage conditions for the desired type of access is satisfied; and granting, in response to receipt of the authorization, the desired type of access". As discussed above, Heaven does not teach at least a second digital property rights module, which is an associated extension rights control module, nor does Heaven teach a digital property rights list that identifies digital property modules.

Heaven further does not teach or suggest "identifying the associated extension rights control module specified in the digital property rights list for generating an authorization for a desired type of access to a data set". Heaven only teaches a single rights module, the local rights module 28, for authorizing access to a data set. The BRM server 14, as taught by Heaven, does not authorize access to a data set. The BRM server 14 "oversees the assignment of rights to users with respect to their digital media purchases". See Heaven at paragraph 0023. The BRM server also stores user profiles, which include the usage rights of a user. If a local copy of a user profile does not exist in the local rights cache 26 on the user system, the local rights module 28 copies the profile from the BRM sever 14. See Heaven at paragraph 0032.

The present invention, on the other hand, not only uses the digital property rights lists to identify both the at least first associated digital property rights module and the at least second associated property rights module, but goes on to recite "identifying the associated extension rights control module specified in the digital property rights list for generating an authorization for a desired type of access to a data set". The first associated digital property rights module residing in the Digital Rights Management core is analogous to a web browser and the second associated digital rights property module is analogous to a browser plug-in. The second associated digital property rights

module is an associated extension rights control module that is separate from the Digital Rights Management Core.

The second associated digital rights property module is used to generate an authorization for a desired type of access not capable of being authorized by the digital rights module residing in the Digital Rights Management core. See for example, the Specification as originally filed at page 9, lines 8-17. Accordingly, Heaven does not teach the above claim element, nor the claims elements of "requesting the authorization for the desired type of access to the data set through the associated extension rights control module; receiving the authorization from the associated extension rights control module if a set of usage conditions for the desired type of access is satisfied; and granting, in response to receipt of the authorization, the desired type of access".

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Heaven.¹ Because the elements in independent claims 1 and 19 of "retrieving a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in a Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core; identifying the associated extension rights control module specified in the digital property rights list for generating an authorization for a desired type of access to a data set; requesting the authorization for the desired type of access to the data set through the associated extension rights control module;

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

receiving the authorization from the associated extension rights control module if a set of usage conditions for the desired type of access is satisfied; and granting, in response to receipt of the authorization, the desired type of access" is not taught or disclosed by Heaven, Heaven does not identically describe each and every element of claims 1 and 19. Accordingly, claims 1 and 19 distinguish over Heaven for at least these reasons. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome and the rejection should be withdrawn.

Independent claims 6, 10, 15, and 24 recite similar claim language as independent claims 1 and 19 discussed above. Therefore, the above arguments with respect to independent claims 1 and 19 are applicable here in support of the allowability of independent claims 6, 10, 15, and 24 and will not be repeated. Accordingly, claims 6, 10, 15, and 24 distinguish over Heaven for at least the reasons stated above.

For the foregoing reasons, independent claims 1, 6, 10, 15, 19, 24 as amended distinguish over Heaven. Claims 2-5, 7-8, 11-4, 16-17, 20-23, and 25-27 depend from claims 1, 6, 10, 15, 19, 24 respectively. Since dependent claims contain all the limitations of the independent claims, claims 1, 6, 10, 15, 19, 24 distinguish over Heaven, as well, and the Examiner's rejection should be withdrawn. However, additional arguments are given with respect to dependent claims 2, 8, 11, 17, 20, and 26 and 5, 14, and 23.

With respect to claims 2, 8, 11, 17, 20, and 26, the Examiner states on pages 4-5 and similar pages 6-7 of the present Office Action that "*Heaven discloses the authenticating the associated extension rights control module see Par. 0020.*" However, as stated above with respect to independent claim 1 and 19, nowhere does Heaven teach an associated extension rights control module. Paragraph 0020 of Heaven does not teach an associated extension rights control module or authenticating an associated extension rights control module. Accordingly, the present invention distinguishes over Heaven for at least these reasons as well.

With respect to claims 5, 14, and 23, the Examiner states on pages 4, 5, and 7 of the present Office Action "*Heaven discloses the extension rights control module having data set, a remote device and external Digital Property Rights library see Par. 0019 & Par. 0044-0046*". However, claims 5, 14, and 23 recite "wherein the associated extension rights control module is located in at least one of the data set, a remote device and an external Digital Property Rights library". As discussed above with respect to independent claims 1, 10, and 19, Heaven does not teach or suggest an associated extension rights control module and therefore, does not teach "wherein the associated extension rights control module is located in at least one of the data set, a remote device and an external Digital Property Rights library". Accordingly, the present invention distinguishes over Heaven for at least these reasons as well.

Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 9, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0188854 A1 Heaven et al. in view of U.S. Patent Publication No. 2002/0174125 to Lucovsky et al. Regarding independent claims 6, 15, and 24, the above arguments with respect to Heaven are applicable here and will not be repeated.

As the Examiner correctly states on page 6, Heaven does not disclose the use of XML. The Examiner goes on to combine Heaven with Lucovsky.² The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Heaven reference taken alone or in view of Lucovsky simply does not suggest, teach, or disclose the patentably distinct claim elements of:

² Applicants make no statement whether such combination is even proper.

accepting a rights request to a data set, wherein the data set is associated with a digital property rights list specified in a rights management language, wherein the digital property rights list identifies at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in the Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core;

determining if the rights request is contained within the digital property rights list;

determining if the associated extension rights control module is required to authorize a requested right that is specified by the rights request;

retrieving the associated extension rights module in response to a determination that the associated extension rights control module is required;

requesting an authorization for the requested right from the associated extension rights module; and

granting the desired type of access in response to the authorization.

The limitations taken "as a whole" in amended independent claim 6 and similarly amended independent claims 15 and 24 are not present in Heaven taken alone or in view of Lucovsky.

Lucovsky teaches a messaging data structure for accessing data in an identity-centric manner (See Lucovsky at Abstract) and is completely silent on "accepting a rights request to a data set, wherein the data set is associated with a digital property rights list specified in a rights management language, wherein the digital property rights list

identifies at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in the DRM core..." as recited for amended claim 6 and similarly for amended claims 15 and 24.

The present invention, unlike Lucovsky, allows for the available types of usages that may be authorized to be flexibly varied by the owners of the copyright. The available types of usages are not fixed and can be extended or added on to by the incorporation of digital property rights modules. In other words, by using digital property rights control modules, especially modules that are separate from the Digital Rights Management core, usage rights can be updated.

Accordingly, claims 6, 15, and 24 distinguish over Heaven alone and/or in combination with Lucovsky for at least this reason.

Further, when there is no suggestion or teaching in the prior art for "determining if the rights request is contained within the digital property rights list; determining if the associated extension rights control module is required to authorize a requested right that is specified by the rights request; retrieving the associated extension rights module in response to a determination that the associated extension rights control module is required; requesting an authorization for the requested right from the associated extension rights module; and granting the desired type of access in response to the authorization", the suggestion cannot come from the Applicants' own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

For the foregoing reasons, independent claims 6, 15, and 24 as amended distinguish over Heaven taken alone and/or in view of Lucovsky. Claims 9, 18, and 27 depend

from claims 6, 15, and 27 respectively. Since dependent claims contain all the limitations of the independent claims, claims 9, 18, and 27 distinguish over Heaven taken alone and/or in view of Lucovsky, as well, and the Examiner's rejection should be withdrawn.

CONCLUSION

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome and that all claims in the application are allowable. No Previously Presented matter has been added. It is believed that the application is now in condition for allowance or alternatively is in better form for consideration on appeal, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully Submitted,

Date: December 5, 2005

By: _____
Attorney for the Applicants
Jon A. Gibbons
(Reg. No. 37,333)

Fleit, Kain, Gibbons, Gutman,
Bongini & Bianco P.L.
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Telephone No.: (561) 989-9811
Facsimile No.: (561) 989-9812

SOM92001001US1

Page 19 of 19

10/051,344